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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/648,693	08/26/2003	Charles L. Nelson	S*E Case 139D	3774

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FLYNN, THIEL, BOUTELL & TANIS, P.C.
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EXAMINER

KOHARSKI, CHRISTOPHER

ART UNIT	PAPER NUMBER
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3763

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	12/26/2006	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/648,693

Applicant(s)

NELSON ET AL.

Examiner

Christopher D. Koharski

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 November 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 34-73 is/are pending in the application.
- 4a) Of the above claim(s) 34-36, 49-53 and 71-73 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 37, 54, 64 and 66 is/are rejected.
- 7) ☒ Claim(s) 38-48, 55-63, 65 and 67-70 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>see attached (x3)</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

Claims 34-36, 49-53 and 71-73 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected group (group II selected), there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 11/16/2006.

Currently claims 37-48, 55-64 and 66-70 are pending for examination in this application.

Claim Objections

Claims 47 and 48 objected to because of the following informalities: Regarding claims 47 and 48, each claim is dependant from one another and neither are independent claims, for the purposes of the rejection below, Examiner will place them with the independent claim set depending from claim 37. ***Appropriate correction is required.***

Information Disclosure Statement

The information disclosure statements (IDS) that were submitted on 8/26/2003, 8/03/2004, and 6/12/2006 are in compliance with the provisions of 37 CFR 1.97. Accordingly, the examiner is considering the information disclosure statements.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct

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from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 37, 54, 64 and 64 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 2, 3, 17, 22 and 27 of U.S. Patent No. 6,623,445 and claims 9 and 11 of U.S. Patent No. 6,213,970. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims in the current pending application are anticipated by the claims in the cited US patent.

Application claim 37 requires:

37. A surgical irrigation system,

comprising:

a handpiece locatable adjacent a surgical site and

comprising an irrigation liquid inlet and an irrigation liquid

outlet;

a motor/pump unit locatable remote from said handpiece

and comprising (1) a motor having a shaft and (2) a housing

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including a receptacle having an end opening, a cover, and a motor receiving member axially opposing said receptacle and cover;

said motor receiving member comprising an end wall and a hollow tubular wall extending from said end wall and defining a recess, said end wall having a hole therethrough, said motor being received in said recess with said shaft extending through said hole in said end wall, said motor receiving member being interposed between said receptacle and cover;

said cover comprising the open ended dome having a roof and a peripheral wall extending from said roof, said motor receiving member being received in said dome, an annular seal ring radially interposed between said motor receiving member and a surrounding portion of said peripheral wall of said dome, said motor receiving member being axially spaced from said roof of said dome by a pumping chamber, an impeller fixed on said shaft about said motor receiving member and disposed in said pumping chamber, said pumping chamber having an irrigation liquid inlet and an irrigation liquid outlet;

an elongate irrigation liquid path connecting said

irrigation liquid outlet of said motor/pump unit to said

irrigation liquid inlet of said handpiece.

While patent claim 2 requires (6,623,445):

2. A surgical irrigator system, comprising: a handpiece for applying irrigation liquid to a surgical site; a motor/pump unit comprising a pumping chamber having a floor, a roof spaced above said floor and a peripheral wall generally upstanding between said floor and roof, said pumping chamber having a liquid inlet substantially coaxial with and opening into said pumping chamber through said roof, said pumping chamber having a pumped liquid outlet extending substantially tangentially through said peripheral wall; said motor/pump unit also having an impeller in said pumping chamber, said impeller comprising a disk-like base fixed on a shaft and having a raised central portion substantially coaxial with and raised toward said inlet, said disk-like base further having an annular portion sloping radially outward from said raised central portion and axially away from said inlet, said impeller further comprising plural circumferentially spaced fluid pumping blades upstanding from said annular portion of said base, said blades being spaced from the rotational axis of said impeller and leaving a central well open upward from said raised central portion of said base and toward said inlet, said blades being of cross sectional shape generally like an airplane wing in which each blade includes an upstanding radially inner edge which is in cross section convexly rounded and relatively blunt and faces said central well, each blade further including an upstanding radially outer edge which is in cross section relatively sharp and faces the perimeter of said pumping chamber, each said blade having a top edge

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sloped radially outward and downward away from said roof substantially parallel to said annular portion of said base, each said blade having an upstanding convexly curved first side extending from said radially inner edge of said outer edge and positionable during rotation of said impeller to face toward said outlet.

While patent claim 9 requires (6,213,970):

9. A surgical irrigator system, comprising:

a handpiece for applying irrigation liquid to a surgical site;

a motor/pump unit connectible to said handpiece and comprising a rotatable shaft, a pumping chamber having a floor, a roof spaced above said floor and a peripheral wall generally upstanding between said floor and roof, said pumping chamber having a liquid inlet substantially coaxial with said shaft and opening into said pumping chamber through said roof, said pumping chamber having a pumped liquid outlet extending substantially tangentially through said peripheral wall;

said motor/pump unit also having an impeller in said pumping chamber, said impeller comprising a disk-like base fixed on said shaft and having a raised central portion substantially coaxial with and raised toward said inlet, said disk-like base further having an annular portion sloping radially outward from said raised central portion and axially away from said inlet, said impeller further comprising plural circumferentially spaced fluid pumping blades upstanding from said sloping annular portion of said base, said blades being

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spaced from the rotational axis of said impeller and leaving a central well open upward from said raised central portion of said base and toward said inlet, said blades being of cross sectional shape generally like an airplane wing in which each blade includes an upstanding radially inner edge which is in cross section convexly rounded and relatively blunt and faces said central well, each blade further including an upstanding radially outer edge which is in cross section relatively sharp and faces the perimeter of said pumping chamber, each said blade having a top edge sloped radially outward and downward away from said roof substantially parallel to said sloping annular portion of said base, each said blade having an upstanding convexly curved first side extending from said blunt radially inner edge to said sharp outer edge and positionable during rotation of said impeller to face toward said outlet.

Thus it is apparent that the application claims are broader than the patent claims and the subsequent patented independent and dependant claims 2, 3, 17, 22 and 27 of U.S. Patent No. 6,623,445 and claims 9 and 11 of U.S. Patent No. 6,213,970 encompass application claims 37, 54, 64 and 64. Following the rationale in *In Re Goodman* cited in the preceding paragraph, where Applicant has once been granted a patent containing a claim for the specific or narrower invention, Applicant may not then obtain a second patent with a claim for the generic or broader invention without first submitting a terminal disclaimer.

Allowable Subject Matter/Claim Objections

Claims 38-48, 55-63, 65 and 67-70 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Atkinson (4,561,431).


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher D. Koharski whose telephone number is 571-272-7230. The examiner can normally be reached on 7:30am to 4:00pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nick Lucchesi can be reached on 571-272-4977. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Date: 12/4/06


Christopher D. Koharski
AU 3763

